

Thelen Reid & Priest LLP

Attorneys At Law

225 West Santa Clara Street, Suite 1200
San Jose, CA 95113-1723Tel. 408.292.5800
Fax 408.287.8040www.thelenreid.com

Adrienne Yeung
Direct Line: (408) 282-1809
Direct Fax: (408) 278-8209
ayeung@thelenreid.com

May 18, 2004

VIA FAX 703.308.5077

#181 Reg for
Refund

06-22-04

Frida Connelly
Refunds Branch
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Request for Refund

Re: United States Patent Application entitled, "EASY CUTTER"

Inventor(s): Ashby et al.

Serial No.: 09/843,496

Filed: April 25, 2001

TRP Docket No.: 034298-000092

Dear Ms. Connelly:

In regards to the above referenced application, Check No. 315540 in the amount of \$130.00 was deposited February 17, 2004, for a Petition from Requirement for Restriction which was enclosed with the filing submitted on February 2, 2004. A copy of the check is attached.

Please note that the Petition fee was submitted in error. A Notice on the Decision on Petition was received on February 24, 2004, which clearly states "The Petition is considered pursuant to 37 CFR 1.141 and 1.181, and that no fee was required". A copy is also attached.

It is respectfully requested that the \$130.00 be reversed to our Deposit Account No. 50-1698 as soon as possible. Please call me should you have any questions. Thank you for your time with this matter.

Sincerely,

Adrienne Yeung

AY/m

Serial/Patent No.: 09/843,496

Filing/Issue Date: 4/23/01

Applicant: Ashby et al

Title: EASY CUTTER

TRP Docket No.: 034298-092

Date Mailed: 2/2/04

Atty/Stcy Initials: REK/AY/r

Docket Due Date:

The following has been received in the U.S. Patent & Trademark Office on the date stamped hereon:

- Amendment/Response (____ pgs.)
 Appeal Brief (____ pgs.) (in triplicate)
 Application - Utility (____ pgs. with cover & abstract)
 Application - Rule 1.53(b) Continuation (____ pgs.)
 Application - Rule 1.53(b) Division (____ pgs.)
 Application - Rule 1.53(b) CIP (____ pgs.)
 Application - Rule 1.53(d) CPA (____ pgs.)
 Application - PCT (____ pgs.)
 Application - Provisional (____ pgs.)
 Assignment and Cover Sheet
 Certificate of Correction
 Certificate of Mailing
 Declaration & POA (____ pgs.)
 Fee Transmittal
 Drawings (informal):
____ # of sheets includes ____ figures
- IDS & PTO 1449 (____ pgs.)
 _____ Pieces of Prior Art Enclosed
 Issue Fee Transmittal
 Submission of Formal Drawings:
____ # of sheets includes ____ figures
 Notice of Appeal
 Postcard
 Preliminary Amendment (____ pgs.)
 Reply Brief (____ pgs.)
 Req and Cert. Not to Publish - Rule 1.213
 Request for Continued Examination (RCE) (____ pgs.)
 Request for Extension of Time ____ Month(s)
 Response to Notice to File Missing Parts
 Copy of PTO Notice to File Missing Parts
 Transmittal Letter (original & copy)
 Express Mail No.: 34298-92
 Check(s) \$130 Check# 34298-92
 Deposit Acc. No. 50-1698 S

Patent Code: 1660
Client/Matter #: 34298-92

0000
 05107-0003-3
 1704
 150.3632 3548 23 27
 2

८६५६७ छैर

RESERVED FOR FINANCIAL INSTITUTION USE

U. S. TREASURY
FOR CREDIT TO THE
02-11-2004
12-10-0001
PATENT AND TRADEMARK OFFICE

PLEASE ENDORSE HERE



UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

IN	MAR 11 2004	UNITED STATES PATENT AND TRADEMARK OFFICE
		COMMISSIONER FOR PATENTS P.O. Box 1450 ALEXANDRIA, VA 22313-1450 www.uspto.gov
THELEN REID & PRIEST LLP		

Paper No. 16

FEB 24 2004

In re Application of
 Mark Ashby et al
 Application No. 09/843,496
 Filed: April 25, 2001
 Attorney Docket No. 034298-000092

DECISION ON PETITION

DOCKETED
MAR - 8 2004

This is a decision on the petition filed on February 6, 2004 by which petitioners request withdrawal of the examiner's requirement to restrict this application a single one of a plurality of patentably distinct inventions and to further elect a single species of the disclosed invention for prosecution in this application. The original requirement was promulgated on May 7, 2003, in paper No. 8 and made final on September 2, 2003, in paper No. 11. The petition is considered pursuant to 37 CFR 1.141 and 1.181, and no fee is required.

The petition is dismissed.

Initially, it is noted that in paper No. 8, the requirement as originally promulgated identified a total of four patentably distinct inventions. Two of these inventions were alleged by the examiner to be related as subcombinations useable together (MPEP § 806.05(d)), a third invention was said to be related to each of the two subcombination inventions as combination-subcombination (MPEP 806.05(c)) and the fourth invention was held to be a method that was distinct from each of the three inventions as method as process of use and the product being used (MPEP § 806.05(h)). In addition, the examiner determined that two patentably distinct species were disclosed and claimed in this application, namely the species Figure 4 which the examiner designated as "species A", and the species of Figure 8, designated by the examiner as "Species B."

Petitioners filed paper No. 9 on June 9, 2003, and in that reply, petitioners traversed the requirement to elect one of the four related but patentably distinct inventions. Petitioners' basis for traversing this requirement appears at page 5 of paper No. 9, and seems to be that the examiner did not demonstrate that the four patentably distinct inventions were also "independent inventions." Petitioners appear to have argued that the examiner failed to demonstrate that these inventions were both "independent and distinct", as required by 35 USC § 121. With respect to the election of species requirement, petitioners argued that the species were also related as distinct inventions, and that under the practice in MPEP § 806.04(b), the examiner was required to demonstrate that the species were patentably distinct under the "distinct inventions" test. It was argued that the species could not be independent inventions because they were interrelated.

Petitioners' traverse was not well taken. First, it has long been the practice to read the statutory language "independent and distinct" as meaning "independent or distinct". For a detailed explanation of why, see MPEP § 802.01.

Second, MPEP § 806.04(b) refers to the situation in which two species of a given device are also disclosed as useable together in a combination. The example given is two different species of clamp, each used at the same time in an overall combination. The species of Figure 4 and the species of Figure 8 are disclosed as being two variations of cutter, and are not disclosed as being useful together in the same combination. Hence, it was unnecessary for the examiner to apply MPEP 806.04(b) and rely upon distinct invention practice as well as species practice in order to support the election of species requirement that was promulgated. The examiner need only have determined that there was at least one claim limited to the species of Figure 4, and at least one claim limited to the species of Figure 8, and that the species were capable of supporting separate patents in order to justify requiring that petitioners elect a single species for prosecution in this application. See MPEP § 808.01.

Final

CP

Date

Application of Ashby et al
Application No. 09/843,496

Paper No. 16
Page -2-

With respect to the instant petition, there are two additional facts. First, petitioners have canceled claims 1-10, 13 and claims 17-26, leaving only claims 11, 12, 14-17 and newly added claim 27 directed to the combination of a cutting device generally having a base having an opening with cutting edges, an articulated flap having cutting edges corresponding to the cutting edges of the opening, and the base being mounted on a card which in turn supports a medical system for delivering foam material. Petitioners' characterization of claims 18-26 as being withdrawn is erroneous, see paper No. 9, page 3.

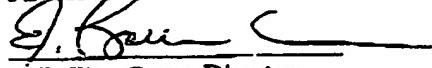
Second, petitioner is now arguing the Constitutionality of the "restriction requirement", that the restriction requirement must be based on claims in accordance with proper MPEP practice, and on a host of other reasons that did not form the basis for the original traverse. Nevertheless, these arguments will be answered, albeit, briefly.

Petitioners' Constitutional argument vis-a-vis the examiner's requirement to elect species is simply inaccurate with respect to what an election of species requirement is, and what the law is. It is not a "restriction requirement"; it is an election of species requirement. Petitioners' hypothetical example of an unconstitutional taking that would occur if one of petitioners' claims reads on both of the species precluding the filing of a divisional application is adequately addressed by 35 USC § 121, which precludes a rejection in a divisional application based upon double patenting of claims asserted in a divisional application that were subject to an election or restriction requirement in a parent application. In addition, 37 CFR 1.146 provides that an applicant will be permitted to claim a reasonable number of species in an application if a generic claim is found to be allowable. Petitioners have not been subjected to any sort of "taking" by reason of the examiner's requirements.

As to the arguments predicated on the proposition that restriction must be based upon claims, a species requirement is based upon embodiments. "*Claims are never species.*", MPEP § 806.04(e). (Emphasis in the original.) With respect to the argument in the penultimate paragraph of page 5 of the petition, it is again pointed out that with respect to the determination that the two species identified by the examiner are patentable over each other, the examiner has acted properly pursuant to MPEP § 808.01.

In summary, the petition presents no basis upon which to disturb the record as it currently exists, or upon which to hold that the examiner abused his discretion or acted in an arbitrary or capricious manner in first requiring restriction, then in requiring an election of species in addition to the restriction requirement, and then in making his requirements final. Therefore, the requested relief cannot presently be granted. Petitioners are entitled to file a request for reconsideration of this decision, which must be filed within two months of the date of this decision. See 37 CFR 1.181(f).

PETITION DISMISSED.


E. Rollins-Cross, Director
Technology Center 3700

Robert E. Krebs
Thelen Reid & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640